

35745

REMARKS**As to the claims in the application**

The Examiner has indicated that the application contains claim 1-25. Applicants respectfully submit that the application actually contained claims 1-29 prior to the present amendment. Claims 13 and 16-22 are amended and claims 14-15 are currently cancelled.

In the Public PAIR record, two sets of claims appear with the date May 4, 2005. One of these has 25 claims and one has an additional 5 claims that were added by the preliminary amendment. That the proper claim set was the set with 29 claims is abundantly clear from the fee calculation which is for 29 claims and the remarks accompanying the amendment which indicates clearly that there were 29 claims filed and paid for upon entry in the USPTO.

As to the propriety of the (premature) division into sub-groups

The applicants respectfully submit that while the election requirement as to inventions between Groups I and II appears to be proper under PCT Rule 13.1, the division into subgroups is not. Applicants further submit that while 35 U.S.C. 121 is applicable to a national filing of a PCT application, it must be interpreted in view of the express statement in 35 U.S.C. §372 quoted below..

PCT rules allow for a post facto non-unity objection with respect to dependent claims only when the parent claim has been found to be unpatentable. Until such finding, there is no provision in the PCT rules (or in 37 CFR 1.499, which is relevant) for a finding of non-unity unless and until the parent claim is found to be unpatentable.

For convenience, 35 U.S.C. §372 and 37 CFR §1.499 are repeated, with the relevant portions highlighted:

35 U.S.C. §272 (b) (2): "the Director may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of *the treaty and the Regulations*;" The regulations referred to are the PCT regulations as is clear from 35 U.S.C. §351 (definitions):

"(b) The term "Regulations," when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term "regulations," when not capitalized, means the regulations established by the Director under this title. when not capitalized, means the regulations established by the Director under this title."

35745

Turning to PCT Rule 13 (which is the only rule which deals with unity of invention):

Rule 13

Unity of Invention

13.1 Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

13.3 Determination of Unity of Invention Not Affected by Manner of Claiming

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

13.4 Dependent Claims

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

13.5 Utility Models

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.

Applicants note that so long as the parent claim has not been found to be unpatentable, the dependent claims form a group of inventions (together with the parent claim) under PCT Rule 13.1 as specifically called out in PCT Rule 13.4. Applicants further note that the present application is not a utility model, so that PCT Rule 13.5 does not apply.

This requirement to follow the PCT rules is recognized in MPEP §1893.03(d), which is too long to repeat here. Applicants note that while the text of this section does not mention any species requirement (since none is available under the PCT rules, before the parent is found to be unpatentable). It does include a form paragraph relating to a species requirement, namely:

371 Applications

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

35745

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicants submit that the Examiner has made a fundamental error in misidentifying the sub-groups as "inventions," in the present action, which they clearly are not, since they all share the same (*prima facie*) patentable elements, namely the elements of their parent claims. Furthermore, applicants submit that the form paragraph is only applicable after the Examiner has made a finding of unpatentability of the parent claim at which point this paragraph makes some sense. Applicants submit that this form paragraph can not refer to a species rejection prior to rejection of the parent claims, since this has no basis in the PCT rules governing non-unity or even in the section discussing the issue in the MPEP.

Applicants position as to the proper grouping of the claims

Claim 13 has been amended to add that the hair is heated by a wire having a temperature greater than 50°C, the special technical feature of claim 1.

Applicants appreciate that claims 1 and 13 as originally worded had two differently worded features which the Examiner indicated cause unity of invention. In particular, Apparatus claim 1 contained the limitation that a wire configured to touch the hair prior to cutting by the blade is heated to a temperature greater than 50°C and claim 13 required that the hair it self is heated to a temperature higher than 50°C before being cut by the blade, without mentioning how it is so heated. However, it is clear that claims 1 and 13 as originally filed shared the same inventive concept, namely heating the hair to a temperature above 50°C, since contact of the hair (which has almost no heat capacity) with a wire at 50°C, as required by claim 1, will cause the temperature of the hair to reach 50°C, as required by claim 13 (the same temperature as the wire). Applicants submit that the *prima facie* special technical feature that unites all the claims is heating the hair to a temperature of more than 50°C and then cutting it with a blade. Claim 13 is a broad method

35745

claim encompassing this invention and claim 1 is a narrower claim which is limited to using a heated wire to perform the heating prior to cutting by the blade.

However, to avoid any doubt, applicants have added the special technical feature of claim 1 so that claim 13 now is a member of Group I. Applicants submit that claims 16-21 should be examined with sub-group Id. For the avoidance of doubt, the amendment to claim 13 has not been added to secure a finding of patentability, but only to overcome a possible restriction requirement.

In summary, applicants submit that unity of invention as defined by PCT Rule 13 is present in the claims. Applicants have marked the claims such that apparatus claims 1 and 5-12 and method claims 13 and 16-21 are under examination and the other claims are withdrawn. Applicants await a final determination of the restriction.

Election

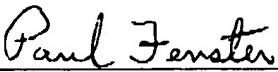
Since applicants are required to elect a group and sub-group if the above arguments are not accepted by the Examiner, applicants elect Group I, subgroup Id, with traverse.

Applicants note that the Examiner has not made any restriction with respect to claims 26-29, so that no election by applicants is required as to these claims. However, in the spirit of the Examiner's position, claims 26 and 27 are marked as being withdrawn and claims 28 and 29 are marked as being under examination (as part of sub-group Id)

The designation of certain claims as being withdrawn is in conformance to the above election and should not be considered as an agreement by applicants to the restriction requirement or the finding of non-unity.

An examination on the merits is respectfully awaited.

Respectfully submitted,
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